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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,818	10/31/2001	Jeffrey G. Wiley	10016464-1	4713

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/003,818

Applicant(s)

WILEY ET AL.

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-24 are presented for examination; claims 1, 14, and 20 independent.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 13-16, and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lopresti et al. (USPN 5,754,308) (hereinafter Lopresti).

3. Referring to independent claims 1, 14, and 20, (e.g. exemplary claim 1), Lopresti discloses a method for providing a remote document history repository (e.g. online document database), comprising:

    sending a document from a multifunction device (an inherent feature since the document must get from the input device to the archive server) (col. 8, lines 1-34); and

    recording delivery data for said sent document in said remote document history repository (i.e. archive server) when said document is sent from said multifunction device (see above), wherein said delivery data is accessible from said remote document history repository independent of said multifunction device (i.e. accessible by numerous

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input and output devices on the network) (Figure 4; col. 6, lines 20-34; col. 7, line 56 to col. 8, line 34).

4. Referring to claim 2, Lopresti discloses accessing said remote document history repository to track document flow (col. 8, lines 14-34).

5. Referring to claim 3, Lopresti discloses sending the document is from a network digital copier (col. 3, line 66 to col. 13; col. 6, lines 20-34).

6. Referring to claim 4, Lopresti discloses updating said remote document history repository to indicate receipt of said sent document (e.g. storing the digital representation) (col. 8, lines 30-34).

7. Referring to claim 5, Lopresti discloses copying said document to said remote document history repository (col. 8, lines 30-34).

8. Referring to claim 6, Lopresti discloses resending said document by sending said copied document from said remote document history repository (col. 1, lines 58-67).

9. Referring to claim 8, Lopresti discloses copying said document to a network site (e.g. archive server) (col. 8, lines 1-34).

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10. Referring to claim 13, Lopresti discloses converting a paper document to an electronic document at a multifunction device fro sending therefrom (col. 7, line 35 to col. 8, line 34).

11. Claims 15, 16, and 21-24 are rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 9, 11, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of Serbinis et al. (USPN 6,584,466) (hereinafter Serbinis).

14. Referring to claims 9 and 17, Lopresti discloses the invention substantively as described in claim 8. Lopresti does not specifically state notifying an intended recipient of said document that said copied document is available from said network site. In analogous art, Serbinis discloses another document archival system which notifies an intended recipient of said document that said copied document is available from said network site (col. 10, lines 35-44). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Serbinis with Lopresti since Lopresti discloses numerous methods of archiving and storing electronic documents however is relatively silent on methods of searching and retrieving these documents from the archive server, which is well known in the art to be necessary in order for the system to be beneficial for the repository. This would lead one of ordinary skill in the art to search for other methods of querying the repository and retrieving documents from the archive server, eventually finding Serbinis and its novel method of accessing the document archival system via previously known web browsers over the Internet and presenting end-users with distinct dedicated websites (e.g. abstract).

15. Referring to claims 11 and 19, Lopresti discloses the invention substantively as described in claim 1. Lopresti further discloses monitoring receipt of said electronic

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document (see above). Lopresti does not specifically disclose resending said electronic document after a predetermined time based on said delivery data recorded in said remote document history repository. In analogous art, Serbinis discloses another document archival system which resends said electronic document after a predetermined time based on said delivery data recorded in said remote document history repository (the office takes the term "predetermined time" to be construed as, "a predetermined event", such as the receipt of a notification email and the establishment of a user session by the recipient) (col. 10, lines 35-54; col. 18, line 22 to col. 19, line 30). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Serbinis with Lopresti since Lopresti discloses numerous methods of archiving and storing electronic documents however is relatively silent on methods of searching and retrieving these documents from the archive server, which is well known in the art to be necessary in order for the system to be beneficial for the repository. This would lead one of ordinary skill in the art to search for other methods of querying the repository and retrieving documents from the archive server, eventually finding Serbinis and its novel method of accessing the document archival system via previously known web browsers over the Internet and presenting end-users with distinct dedicated websites (e.g. abstract).

Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of Cullen et al. (USPN 5,893,908) (hereinafter Cullen).

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16. Referring to claim 10, Lopresti discloses the invention substantively as described in claim 1. Lopresti does not specifically state that the system notifies the user if the document is undeliverable. In analogous art, Cullen discloses another document archival system which notifies the user when a document already exists within a database (i.e. is undeliverable since there exists a copy of the document in the database already) (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Cullen with Lopresti since Lopresti discloses numerous methods of archiving and storing electronic documents however is relatively silent on methods of searching and retrieving these documents from the archive server, which is well known in the art to be necessary in order for the system to be beneficial for the repository. This would lead one of ordinary skill in the art to search for other methods of querying the repository and retrieving documents from the archive server, eventually finding Cullen and its novel method of querying the database with search keys (col. 5, line 55 to col. 6, line 45).

17. Claim 18 is rejected for similar reasons as stated above.

Claims 7 and 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of Hull et al. (USPN 5,978,477).

18. Referring to claim 7, Lopresti discloses the invention substantively as described in claim 5. Lopresti does not specifically disclose redirecting the document by sending



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the copied document from the repository to another recipient. In analogous art, Hull discloses another document archival system wherein the document is redirected sending the copied document from the repository to another recipient (col. 6, lines 15-40). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hull with Lopresti to further simplify the user interface of Lopresti which requires the user to determine numerous selections (i.e. Photocopy or Electronic mode, Paper and Electronic or Print and Archive output) whereby the user interface of Hull will automatically enable the user to automatically archive the document efficiently as stated in Hull (col. 1, lines 22-31).

19. Referring to claim 12, Lopresti discloses the invention substantively as described in claim 1. Lopresti does not specifically disclose the recording said delivery data is transparent to a user of the device. In analogous art, Hull discloses another document archival system wherein the recording of delivery data is transparent to the user (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hull with Lopresti to further simplify the user interface of Lopresti which requires the user to determine numerous selections (i.e. Photocopy or Electronic mode, Paper and Electronic or Print and Archive output) whereby the user interface of Hull will automatically enable the user to automatically archive the document efficiently as stated in Hull (col. 1, lines 22-31).

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***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
21. Cullen et al. (USPN 6,592,629) discloses remote document image storage and retrieval for a multifunctional peripheral.
22. Fredell et al. (USPN 6,678,698) discloses computerized method and system for communicating and managing information used in task-oriented projects.
23. Hull et al. (USPN 6,684,368) discloses specifying delivery information for electronic documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

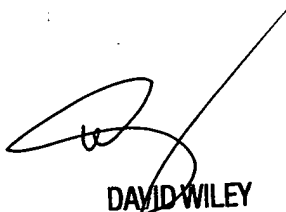
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA

December 16, 2004



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SUPERVISORY PATENT EXAMINER  
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